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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/813,453  | 03/20/2001  | R. Rogers Yocum      | OGZ-001             | 3274             |
| 959   | 7590        | 02/24/2004           | EXAMINER            |                  |
| LAHIVE & COCKFIELD, LLP.<br>28 STATE STREET<br>BOSTON, MA 02109 |             |                      | LUCAS, ZACHARIAH    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1648                |                  |

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/813,453 | <b>Applicant(s)</b><br>YOCUM ET AL. |  |
|                              | <b>Examiner</b><br>Zachariah Lucas   | <b>Art Unit</b><br>1648             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-12, 14, 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-12, 14 and 37 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of the Claims*

1. Currently, claims 2-12, 14, and 37 are pending in the application. In the Response, filed on December 2, 2003, the Applicant cancelled previously pending claims 1, 13, 15, and 17-25; and amended claims 2-5, 7, 9, 11, 12, 14, and 37. The Applicant provided additional remarks in traverse of the restriction requirement. However, as the claims to the other Groups have been cancelled, the arguments are moot in the present application.

2. In view of the amendments to the claims, and the arguments made in the Response, claims 2-12, 14, and 37 are allowed.

### *Sequence Listing*

3. The Applicant was required to correct the sequence listing in the prior action. In view of the papers submitted on September 15, 2003, which corrected the problems with the sequence listing, the requirement is withdrawn.

### *Specification*

4. **(New Objection)** The specification is objected to for containing referring to sequences without also identifying them by the sequence identifier assigned to them in the sequence listing as required by 37 CFR 1.821(d). See e.g., Figure 6, and the description of figure 6 on pages 3-4.

The examiner would like to bring the applicant's attention to the following excerpt from MPEP

§2422.03:

37 CFR 1.821(d) requires the use of the assigned sequence identifier in all instances where the description or claims of a patent application discuss sequences regardless of whether a given sequence is also embedded in the text of the description or claims of an application. This requirement is also intended to permit references, in both the description and claims, to sequences set forth in the "Sequence Listing" by the use of assigned sequence identifiers without repeating

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the sequence in the text of the description or claims. Sequence identifiers can also be used to discuss and/or claim parts or fragments of a properly presented sequence. For example, language such as "residues 14 to 243 of SEQ ID NO:23" is permissible and the fragment need not be separately presented in the "Sequence Listing." Where a sequence is embedded in the text of an application, it must be presented in a manner that complies with the requirements of the sequence rules.

The applicant is therefore required to amend the specification to comply with 37 CFR

1.821(d).

### ***Drawings***

5. **(Prior Objection-Withdrawn)** In the prior action, the Applicant was required to submit new drawings in this application because the sequence identification numbers associated with the various bacterial proteins in Figure 6 do not appear to match the bacterial species given for those sequence identifiers in the sequence listing. In view of the cancellation of the numbers from the figures, this objection is withdrawn. However, the Applicant's attention is redirected to the New Objection with reference to the specification above.

### ***Claim Rejections - 35 USC § 112***

6. **(Prior Rejection- Withdrawn)** Claim 37 was rejected in the prior action under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of identifying antibiotics by identifying compounds that reduce the activity of pantothenate kinase, does not reasonably provide enablement for such methods by identifying compounds that either bind to (no affect on activity) or increase pantothenate kinase activity. In view of the amendment of the claim, the rejection is withdrawn.

7. **(Prior Rejections- Withdrawn)** Claims 37, and 1-14 were rejected in the prior action under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement,

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under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, and under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejections are withdrawn in view of the Applicant's arguments in traversal thereof, which were persuasive.

***Claim Rejections - 35 USC § 102***

8. **(Prior Rejection- Withdrawn)** Claims 37 was rejected under 35 U.S.C. 102(e) as being anticipated by Dougherty et al., WO 01/49721. In view of the arguments made in traversal of the rejection, which were persuasive, the rejection is withdrawn.

***Allowable Subject Matter***

9. The following is a statement of reasons for the indication of allowable subject matter:

In the prior action, the claims were rejected because it was not clear how those in the art would be able to recognize, and distinguish from other proteins, proteins falling within the genus referred to as CoaX proteins by the Applicant. In the Response, the Applicant argued that CoaX proteins are proteins with pantothenate activity and that, when aligned with the other sequences as shown in Figure 6, share the identifying characteristics indicated in that Figure. In particular, in view of Applicant's arguments (e.g. page 12 of the Response) a CoaX protein is interpreted as having each of the conserved residues identified with a \* in Figure 6, and a conservatively substituted residue as indicated in the other marked positions.

***Conclusion***

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10. Claims 2-12,14 and 37 are allowed.

11. This application is in condition for allowance except for the following formal matters:

The lack of sequence identifiers for the sequences disclosed in Figure 6 of the specification must be corrected.


Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

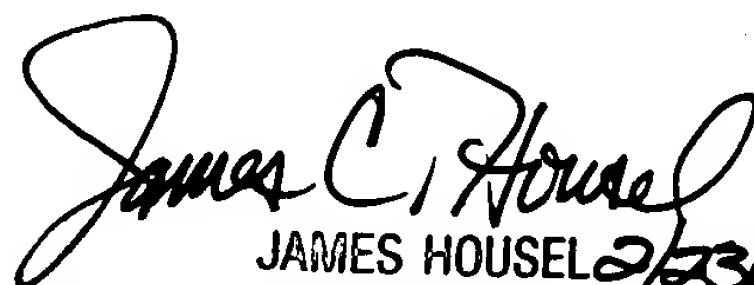
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Z. Lucas  
Patent Examiner



JAMES HOUSEL 2/23/04  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600